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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 1420

NOVO INDUSTRIAL CORPORATION, *Petitioner,*

v.

STANDARD SCREW COMPANY, *Respondent.*

BRIEF FOR RESPONDENT

Respondent, Standard Screw Company, takes the position that no Writ of Certiorari should issue to review the judgment of the United States Court of Appeals for the Seventh Circuit in the above-entitled action.

QUESTIONS PRESENTED FOR REVIEW

No proper question has been presented for review in the Petition for Certiorari, and what is more, the question presented is a moot one insofar as the ultimate determination of the case is concerned.

Petitioner makes the misstatement in proposed Question 1 that the subsequent evolution of a device may not be used as *the sole test* of "obviousness." It was not so used in this case as the decisions of the District Court and Court of Appeals clearly indicate.

The same misstated question is re-stated in different words in Petitioner's Question 2.

ARGUMENT

There appears to be no reason to re-state to this Court what the District Court and the Court of Appeals have already stated. (Appendices A and B to Petition.) The District Court after a full hearing with numerous witnesses and expert testimony and with a number of prior patents before it, held the patent in suit to be both invalid and non-infringed. The Seventh Circuit Court of Appeals upheld the District Court but did not find it necessary to go into the question of infringement since an invalid patent cannot be infringed. Petitioner, here, has not controverted the ruling of non-infringement, made by the District Court and left standing by the Appellate Court.

The one point that Petitioner attempts to make is that the substantially contemporaneous work of Respondent's engineers cannot be considered in deciding whether or not the alleged invention was obvious at the time it was made. It is Respondent's position that this is material evidence that can help to show the Court that what the patentee did was obvious at the time he did it.

The questions the Petitioner presents are moot rather than controlling in this litigation. Both the District Court and the Court of Appeals considered other patents prior to the patent in suit and the testimony of witnesses including expert witnesses, and came to the conclusion in the light of such prior patents and expert testimony that what the patentee did would have been obvious to one skilled in the art at the time that he did it.

The District Court and the Court of Appeals *did not,* as Petitioner would have this Court believe, make the decision based solely upon what three independent engineers did in the field at about the time the patentee was designing his valve. This was not the test at all. The test applied is crystal clear from that part of the Court of Appeals decision of February 8, 1967, which appears in pages 22-23 of Appendix A of the Petition.

Respondent urges that the designing of a relatively simple device by several people at substantially the same time is evidence that the designing did not amount to invention because it was obvious, but Respondent does not believe that this Court's time should be consumed in ruling upon the point when it would in no way change the ultimate decision.

Respectfully submitted,

THOMAS A. REYNOLDS, JR., ESQ.
Winston, Strawn, Smith
& Patterson
First National Bank Building
Chicago, Illinois 60603

ROBERT F. DAVIS, ESQ.
JOHN H. LEWIS, JR., ESQ.
Stevens, Davis, Miller
& Mosher
Suite 300 Munsey Building
Washington, D. C. 20004

Attorneys for Respondent